

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: **Robert J. Davidson**
Assignee: **SEAGATE TECHNOLOGY LLC**
Application No.: **09/760,242**
Filed: **1/12/2001**
For: **PERSONAL MOVIE STORAGE MODULE**

Group Art: **2424**
Examiner: **James R. Sheleheda**

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

ATTENTION: Board of Patent Appeals and Interferences

APPELLANT'S REPLY BRIEF

The Office erroneously asserts a written description rationale for the rejection despite the fact there is no written description rejection on appeal.

The Office's position is that Appellant is allegedly "twisting" the claim language into a meaning not supported by the requisite written description:

On pages 6-8, appellant argues that the plain meaning of claim 1 is that the encoding step writes the access instructions to the module but not to the already stored non-encoded entertainment media.

In response, it is noted that appellant is twisting the claim language in an attempt to claim subject matter which is not supported by the application as originally filed, as which has been repeatedly rejected as such in prior office actions.

While appellant's specification discloses storing access instructions in the module (page 5, lines 10-32), there is no support for encoding the module without encoding the stored entertainment media. The specification is silent as to how and where the access instructions are stored within the module. There is no specific disclosure of what method is used to "encode" the access instructions within the module (page 5, lines 28-31) and whether or not the media programs are modified or encoded.¹

¹ Answer pg. 14.

Importantly, there is no written description rejection presently on appeal. The last written description rejection in the record was in the Office Action dated 3/10/2009. Appellant obviated that rejection in its Response filed 9/10/2009 by amending independent claims 1 and 9 to more particularly recite the present form on appeal. Particularly, the rejected claims on appeal explicitly define the non-encoded entertainment media as being not encoded with any usage condition, and also explicitly feature the encoding as defining a usage condition of the (still existent) non-encoded entertainment media:

*storing...non-encoded entertainment media that is not encoded with any authorized usage condition...encoding...access instructions defining a prescribed authorized usage condition of the stored non-encoded entertainment media.*²

In obviating the written description rejection Appellant pointed to the fact that the specification discloses that the module, not necessarily the previously stored entertainment media, is encoded with instructions defining usage conditions.³ Appellant also showed that the skilled artisan having read the specification readily understands that the controller functions to control usage of the stored entertainment media, and that the controller is certainly part of the module.⁴

The Office did not carry the written description forward after Appellant's Response of 9/10/2009, evidencing the fact that for purposes of appeal the written description rejection issue was in fact obviated.⁵

Contrary to the Office's allegation of "twisting" the claim language, the skilled artisan readily understands that by explicit antecedent basis the claim plainly features the encoding the module with usage conditions as not altering the fact that the previously introduced non-encoded entertainment media resides in the memory. The following statement by the Office to

² Excerpt of claim 1, claim 9 recites the same subject matter.

³ Applicant's Response filed 9/10/2009 ppg. 10-11.

⁴ *Id.*

⁵ Applicant noted in its Pre-Brief Request filed 7/13/2010 that the Office's raising a non-reference issue without a concomitant Section 112 rejection left an unresolved factual issue making the case not ready for appeal.

the contrary, taking the position that the claims merely require the entertainment media be stored before the encoding occurs, is reversible error:

The current claims, however, indicate that “non-encoded entertainment media” is first stored, and that after that non-encoded entertainment media is stored, then access instructions are encoded into the storage. Thus, the claims merely require that the entertainment media be stored *prior* to the access instructions. Once the entertainment media is fully stored, the access instructions can then be encoded onto the storage. The claims do not require that the entertainment media *stay* unencoded with authorized usage conditions, but merely that they are stored first without the usage conditions.⁶

Again, the rejected claims plainly introduce storing non-encoded entertainment media, and then by antecedent referral explicitly recite encoding the module to define a usage condition of the stored non-encoded entertainment media. Contrary to the Office’s position, the claim language in fact does not merely feature the entertainment media being stored prior to the encoding; rather, the claim language in fact does feature the entertainment media staying non-encoded after the encoding.

It was entirely within the Office’s discretion whether to reject the claims for an alleged lack of written description support. The Office chose not to, despite Appellant’s pointing out in the record that the issue left unresolved made the case not ready for appeal. It is reversible error for the Office to now raise a written description issue, in the absence of any written description rejection, as a veiled attempt to show that Appellant is allegedly twisting the claim language beyond its broadest reasonable meaning.

⁶ Answer pg. 15.

The Office mischaracterizes what the skilled artisan readily understands Kawakami to disclose.

Appellant reiterates from its Appeal Brief that the skilled artisan readily recognizes that Kawakami only discloses storing encoded content to the portable devices, and incorporates that reasoning herein in its entirety.⁷

The Office's position in its Answer is that Kawakami's content data base 114 stores content 161 in a separate file from the corresponding usage rule 162 for that content 161. However, the skilled artisan readily understands that nowhere does Kawakami disclose or suggest transferring any content file 161 without also transferring its corresponding usage rule 162. Even in the passage cited by the Office it is clear the check in/check-out management program 132 checks out content 161 based on the corresponding usage rule 162:

Based on a setting of either check-in or check-out and usage rule files 162-1 to 162-N recorded in a content data base 114, the check-in/check-out management program 132 checks out contents stored in content files 161-1 to 161-N to any of the portable devices 6-1 to 6-3, or checks in contents stored in the portable devices 6-1 to 6-3.⁸

The Office also maintains its position that the Kawakami's FIGS. 13 and 19 allegedly disclose first transferring the content 161 and then separately transferring the usage rule 162. In addition to the rebuttal argument in Appellant's Brief, incorporated herein in its entirety, the skilled artisan readily comprehends that the content referred to in block S59 of FIG. 13 is previously selected in block S54 and then paired with its corresponding usage rule file in block S55 before being transferred:

Next at step S54, the move management program 134 reads information on a content recorded in the music data base (included in the content data base 114) formed in the HDD 21, and makes the display/operation-instructive program 112 display the information as a selecting GUI on the display unit 20. The user clicks a music piece title (content name) and button 216 displayed in the field 212 in FIG. 5 to select the content to be moved from the HDD 21 to the

⁷ Appeal Brief ppg. 9-13.

⁸ Col. 14:46-51 cited by Office in the Answer pg. 18.

portable device 6. Next at step S55, the move management program 134 examines the playback condition, copying condition, playback accounting condition, etc. for the content having been selected at step S54. This operation will further be described later with reference to the flow chart in FIG. 15.⁹

The Office has failed to substantiate any evidence that Kawakami discloses or suggests at least the featured *storing...non-encoded entertainment media that is not encoded with any authorized usage conditions* of independent claims 1 and 9. Its rationale in an attempt to do so simply mischaracterizes what the skilled artisan readily understands Kawakami to disclose or suggest.

CONCLUSION

For the reasons set forth above, Appellant respectfully requests that the rejections of all claims on appeal be reversed.

Respectfully submitted,

By: /Mitchell K. McCarthy/
Mitchell K. McCarthy, Registration No. 38,794
McCarthy Law Group
512 Northwest 12th Street
Oklahoma City, Oklahoma 73103
www.mccarthyiplaw.com
1.877.6546652 or 405.639.3082

⁹ Kawakami col. 26:54-67 (emphasis added).